REMARKS

Claims 1-77 are pending in this application. Claims 45-48 have been withdrawn from consideration. Claims 1-44 and 49-77 have been rejected.

Claims 29, 30, and 44 have been amended to correct typographical errors.

Claims 49, 50, 52, 63, 64, 70, and 77 were rejected under 35 U.S.C. §102(a). Claims 1-44, 51, 53-62, 65-69, and 71-76 were rejected under 35 U.S. C. §103(a). A marked-up version of the changes made to the claims by this amendment is attached.

Rejections under 35 U.S.C. § 102(a)

The Office has rejected claims 49, 50, 52, 63, 64, 70, and 77 under 35 U.S.C. §102(a) as being anticipated by Bonner, R. et al., "Laser Capture Microdissection: Molecular Analysis of Tissue," Science, Vol. 278, Nov. 21, 1997, pp.1481-1483 (hereinafter "Science article"). 35 U.S.C. §102(a) states that:

> A person shall be entitled to a patent unless--
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

The present application was filed on December 4, 1997 and is a continuation-in-part of U.S. Ser. No. 60/060,732 that was filed on October 1, 1997 (hereinafter "parent application"). The Science article has a publication date of November 21, 1997. The parent application predates the Science article. Therefore, the Science article is not prior art under §102(a) and applicants respectfully request withdrawal of this rejection.

Rejections under 35 U.S.C. §103(a)

The Office has rejected claims 1-44, 51, 53-62, 65-69, 71-76 under 35 U.S.C. §103(a) as being unpatentable over Bonner, R. et al, "Laser Capture Microdissection: Molecular Analysis of Tissue," Science, Vol. 278, Nov. 21, 1997, pp.1481-1483 (hereinafter "Science article") in view of U.S. Patent No. 5,633,535 issued on May 27, 1997 to Chao et al. (hereinafter "Chao") or

U.S. Patent No. 5,621,619 issued on April 15, 1997 to Seffernick et al. (hereinafter "Seffernick") or U.S. Patent No. 3,995,941 issued on December 7, 1976 to Nagahara et al. (hereinafter "Nagahara"). Only subject matter that is prior art under §102 can be used to support a rejection under §103. MPEP 2141.01(I). For the reasons discussed above, the Science article is not prior art under §102(a) and, therefore, cannot be used to support a rejection under §103(a).

Furthermore, each of the references, Chao, Seffernick, and Nagahara, alone or in any combination with each other is insufficient to sustain a rejection under §103(a) because the references fail to disclose teach or suggest all of the elements of the claims. Therefore, Chao, Seffernick and Nagahara, alone or in combination, cannot support a rejection under §103(a). For these reasons applicants respectfully request withdrawal of the rejection under §103(a).

On page 4, the Office Action makes reference to article XP000644727 with respect to claims 36 and 69. Applicants do not understand what article is being referenced by the above designation and respectfully request more precise identification of this article. Nonetheless, dependent claims 36 and 69 state that the transfer film includes a transparent thermoplastic. Since this article was applied only against claims 36 and 69 and not against their respective independent claims, applicants believe it would not render claims 36 and 69 unpatentable, because claims 36 and 69 are dependent claims incorporating all the elements of their respective independent and intervening dependent claims. Accordingly, applicants respectfully request allowance of all claims.

CONCLUSION

Applicants have, by way of the amendments and remarks presented herein, made a sincere effort to overcome rejections and address all issues that were raised in the outstanding Office Action. Accordingly, reconsideration and allowance of the pending claims are respectfully requested. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 4857772000400. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: August 3, 2001

By: _____

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

29. (Amended) The integral portion of a biological reaction vessel according to claim 16, wherein said laser capture microdissection transfer film includes a protruding feature that runs along at least **[at least]** three points of a perimeter of said laser capture microdissection transfer film.

30. (Amended twice) A microcentrifuge tube cap, comprising an integral portion of a biological reaction vessel including:

a transfer film carrier having a substrate surface; and

a laser capture microdissection transfer film coupled to said substrate surface of said transfer film carrier, wherein said laser capture microdissection transfer film includes at least one integrally formed structural feature that protrudes and provides a controllable spacing between said laser capture microdissection transfer film and a sample.

44. (Amended twice) A set of microcentrifuge tube caps, comprising a laser capture microdissection assembly including:

a plate having a top surface; and

at least one laser capture microdissection cap coupled to said top surface of said plate, wherein said at least one laser capture microdissection cap includes:

a transfer film carrier having a substrate surface; and

a laser capture microdissection transfer film coupled to said substrate surface of said transfer film carrier, wherein said laser capture microdissection transfer film includes at least one integrally formed structural feature that protrudes and provides a controllable space in between said laser capture microdissection transfer film and a sample.